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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,570	09/25/2001	Geroge Roland Hill	P268453	4578

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Pillsbury Winthrop LLP
1600 Tysons Boulevard
McLEAN, VA 22102

EXAMINER

LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

11

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,570

Applicant(s)

HILL ET AL.

Examiner

Jerry A. Lorengo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 24 and 25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: .

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DETAILED ACTION

(1)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 discloses a process of imaging an imperforate substrate comprising the general steps of: applying a base layer to the imaging surface of a substrate; applying at least two continuous superimposed layers of a marking material onto the base layer; removing portions of the superimposed layers of marking material while they are supported by the base layer; and removing the base layer from the substrate whereby at least one of the two layers of marking material is applied to the substrate.

It is not understood, however, how at least one of the two layers of marking material can be applied to the substrate when, according to claim 24, the marking material layers are supported on the base layer which is interposed between the layers of marking material and the substrate. Clarification is required.

(2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,321,778 to Whitehead in view of U.S. Patent No. 1,199,882 to Frey.

Whitehead discloses a process of imaging an imperforate substrate having a substantially uniform imaging surface (glass) to form a one-way vision panel comprising the steps of (Figures 1-3; column 43-45; column 3, lines 3-28):

- (1) Providing a glass substrate;
- (2) Applying at least two layers of marking material (white and black layers of ink) in an imagewise pattern (dots) on the substrate; and
- (3) Firing the substrate to fuse the layers of marking material to the substrate.

Although Whitehead discloses that the starting substrate (the glass panel) is transmuted (tempered) upon firing, he does not specifically disclose, as per applicant claim 25, that the two layers of marking material are applied to the starting substrate continuously, followed by removal of portions of the marking material by a force selectively supplied to the marking material while it is supported by the substrate.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of whitehead to provide the two layers of marking material on the substrate in a continuous manner motivated by the fact that Frey, also drawn to methods of forming a one-way vision panel (a mirror), discloses that it is known to apply at least two layers of marking material 2,3 in a continuous manner across the surface of a glass panel 1 followed by

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the removal of portions of the marking material by a force, i.e., graving, selectively applied to the two layers of marking material while it is supported by the glass panel 1 (Figures 1-3; page 1, column 1, lines 31-48).

(3)

Allowable Subject Matter

Claims 1-23 are allowed.

Claim 24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Methods for the imaging of substrates having a substantially uniform imaging surface, such as those disclosed by U.S. Patent Nos. 6,258,199 to Lingamfelter et al.; 5,344,680 to Logan et al.; 5,312,645 to Dressler; 5,112,423 to Liebe, Jr.; 5,026,584 to Logan; and 3,826,167 to Pelet et al., are known in the art. Dressler, for example, discloses one method comprising the steps of : Providing an imperforate base layer; Applying two continuous marking layers and an adhesive layer onto the surface of the base layer; Applying a selectively applied force (cutting) to the marking material layers and adhesive layer remote from the base layer while the marking material layers and adhesive layer are supported by the base layer; Removing (weeding) non-image areas of the marking material layers and adhesive layer from the base layer while leaving non-removed (image) portions of the marking material layers and adhesive layer on the base layer; Providing a substrate 36 having a substantially uniform imaging surface; Contacting the image portions of the marking material layers and adhesive layer supported on the base layer against the substantially uniform imaging surface of the substrate to bond the image portions thereto; and Transferring the image portions to the substrate by removing the base layer therefrom. Although Lingamfelter et al. discloses that such cut graphics are applicable to many types of substrates including glass, none of the prior art of record specifically teaches or suggests such a method wherein the step of contact and transfer comprises the direct contact of at least one of the two marking layers carried on the base material with the imaging surface of the substrate.

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(4)

Conclusion


The examiner has considered the references cited in the PCT document upon which this application is based. References C-H listed on Form PTO-892 have been cited by the examiner as having particular relevance to the subject matter at hand.

(5)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (703) 306-9172. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


J.A. Lorengo
Primary Examiner
AU 1734
December 9, 2002